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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/806,818	03/22/2004	Masashi Hiroki	04190/LH	3706
1933 7590 06/29/2007 FRISHAUF, HOLTZ, GOODMAN & CHICK, PC 220 Fifth Avenue 16TH Floor NEW YORK, NY 10001-7708			EXAMINER MCCLENDON, SANZA L	
			ART UNIT 1711	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/806,818	Applicant(s) HIROKI ET AL.	
	Examiner Sanza L. McClendon	Art Unit 1711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 June 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) 3-10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 11-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on June 12, 2007 has been entered.

Response to Amendment

2. In response to the Amendment received on June 12, 2007, the examiner has carefully considered the amendments. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

Response to Arguments

3. Applicant's arguments filed June 12, 2007 have been fully considered but they are not persuasive. Applicant appears to be relying on the limitation "the color ink and the reaction liquid being mixed together immediately before being introduced into an ink jet-type recording head" to overcome the rejections. For the rejection of claims under Mantell et al (EP 0 779 346), these arguments are not convincing. Firstly, applicant is claiming an ink composition and the amended subject matter added is a process/method limitation step which are not deemed to change the overall composition (i.e., the color ink and the reaction liquid). Secondly, Mantell et al sets forth that the initiator can be deposited on the substrate before, while or after the ink is ejected to the substrate. The teaching that the initiator solution can be deposited while the ink is ejected onto the substrate. It is deemed that it is within an ordinary skill artisan level to recognize this teaching to mean 1 or 2 possible things. That is depositing from the same head or from a different head but regardless it is deemed that the newly amended subject matter is found in the reference.

Applicant states claims 24 to 27 were not included in the rejection under 102(b) by Mantell. The examiner disagrees the rejection was for claims 1-2, 11-14, 17-18 and 23-28 wherein this included claims 24 thru 27.

Regarding applicant's arguments for the 35 USC 103(a) rejection by Ushirogouchi et al in view of Mantell et al, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., page 80, lines 15 to 25 and page 4, lines 26 to page 5) are not recited in the rejected claim(s). Although the claims are interpreted in light

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of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Thus the rejections still stand. US 5,641,346 to Mantell et al will be added to the anticipation rejection by Mantell et al (EP 0 779 346). US 6,959,986 to Ushirogouchi et al will be added to the obviousness rejection by Ushirogouchi et al. Lastly, the recitation for an ink jet has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-2 and 11-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ushirogouchi et al (EP 1 357 159 and 6,959,986) in view of Mantell et al (EP 0 779 346 and 5,641,346).

Ushirogouchi et al teaches liquid inks for ink-jet applications. Said ink comprises a photo-acid generating agent that generates an acid upon exposure to irradiation, a coloring component, and at least one kind of polymerizable solvent that is polymerized in the presence of an acid. Said polymerizable solvent contains at least 50 parts by weight a compound having an alicyclic skeleton and/or an aliphatic skeleton having a viscosity of 50 mPa*s or less and a boiling point of 150 °C or more under room temperature and atmospheric pressure. The ink composition should have a fluidity of at least 30 cp. For this to be satisfied it is desirable to mix different kinds of polymerizable solvent monomers, such as compounds having the formulas (1) or (2), see page 19, which have a viscosity of about 1 to 30 cp, and compounds having the general formula (3), see page 20, which has a viscosity of between 20 to about 500 cp. The compounds disclosed by Ushirogouchi et al of general formulas (1), (2) and (3) appear to anticipate claims 11-14, 18-19, and 21-22, wherein formulas (1) – (3) read on the latter claims. The ratio

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of high viscosity to low viscosity polymerizable solvent is disclosed as being from 1:1 or 1:10—see page 20. This appears to read on claim 20. Said ink can further comprise oxetane compounds and vinyl ether compounds for improving transfer capabilities, adjusting viscosity, and improvement in the photocurable rate. Per sections [0048] through [0063], Ushirogouchi et al teach adding pigments and powdery materials to said polymerizable solvent. The particles size of said pigments and powder is disclosed as being from 0.1 to 0.3 microns. Additionally, basic compounds such as those found in section [0108] can be added to said ink composition to suppress corrosion in the ink jet head of a recording apparatus—see page 24. When printing on surfaces that exhibit strong basic character it is possible to suppress the effects of the generated acid on the substrate by adding a radically polymerizable compound, such as an (meth) acrylate, vinyl or styrene based compounds. Said acid generating compounds are found on pages 5-16, wherein at least some of those in claim 27 can be found. The method claim 28 can be found in the reference in said examples and throughout the disclosure.

Ushirogouchi et al does not expressly teach preparing and preserving the photo-acid generating compound as a separate solution. However, this is a known process step in the art of ink jet compositions and printing methods. Mantell et al teaches a similar ink composition comprising an liquid epoxy or vinyl ether component, a colorant, and a photo-acid generating onium salt, wherein said composition can further comprise pH adjusting agents, such as basic compounds, vinyl compounds. Mantell et al teaches that said photo-acid generating compound can be kept separate from the curable ink composition until the ink is ejected, which can be jetted onto the substrate prior to the ink composition. This ensure that the ink will not polymerize in the print-head regardless of the amount of stray light that reach the front face of the nozzles, thus maintaining the stability of the ink composition until use.

Ushirogouchi et al and Mantell et al are analogous art because they are from the same field of endeavor that is the art of cationically cured inkjet ink compositions. Therefore it would have been obvious for an artisan of ordinary skill in the art to prepare and separate the photo-acid generating compound from the polymerizable ink composition and its components as suggested by Mantell et al in ink compositions as taught by Ushirogouchi et al. The motivation would have been a reasonable expectation of obtaining a stable ink composition as taught by Mantell et al in the absence of evidence to the contrary.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-2, 11-14, 17-18, and 23-28 are rejected under 35 U.S.C. 102(b) as being anticipated by Mantell et al (EP 0 779 346 and 5,641,346). Note all line and column use are from EP 0 779 346.

Mantell et al teaches a ink composition comprising an liquid epoxy or vinyl ether component, a colorant, and a photo-acid generating onium salt, wherein said composition can further comprise pH adjusting agents, such as basic compounds, vinyl compounds. Mantell et al teaches that said photo-acid generating compound can be kept separate from the curable ink composition until the ink is ejected, which can be jetted onto the substrate prior to the ink composition. This ensure that the ink will not polymerize in the print-head regardless of the amount of stray light that reach the front face of the nozzles, thus maintaining the stability of the ink composition until use. Per example 1, Mantell et al teaches his polymerizable compound to be a mono-vinyl ether compound, which has a boiling point of 208 0C and a molecular weight of 132.16 in combination with a pigment dispersion, which is prepared separately from the photo-acid generating composition (see example 6). Example 6 is deemed to read on claim 28. Said photo-acid generating agents can be found on page 4, which appear to anticipate at least some of those found in claim 27. Said pigments are disclosed as having average particle sizes in range from 0.005 to 0.3 microns—see page 4. The teachings of the reference are deemed to anticipate the instantly claimed invention of the above listed claims.


Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sanza L. McClendon whose telephone number is (571) 272-1074. The examiner can normally be reached on Monday through Friday 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (571) 272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Sanza L. McClendon
Examiner
Art Unit 1711

SMc